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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/536,596 | 05/26/2005 | Christian Spindler | HUBR-1282 | 9219 |
| 24972 | 7590 | 12/24/2008 | | |
| FULBRIGHT & JAWORSKI, LLP | | | EXAMINER | |
| 666 FIFTH AVE | | | WOODWARD, ANA LUCRECIA | |
| NEW YORK, NY 10103-3198 | | | | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1796 | | |
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| | | 12/24/2008 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/536,596

Applicant(s)

SPINDLER ET AL.

Examiner

Ana L. Woodward

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005, October 16, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-39 is/are pending in the application.
- 4a) Of the above claim(s) 22-28-31, 33-35, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21, 23-27, 32, 36 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I comprising gelatin as the polyamide base species and a side chain of formaldehyde and sodium sulfite in the reply filed on October 16, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 22, 28-31, 33-35, 37 and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species or group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 16, 2007.

Claim Rejections - 35 USC § 112

3. Claims 19-21, 23-27, 32, 36 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, the misspelled term "degradable" is noted.

In claim 19, it is unclear as to what is meant by "aminoplast former-free".

In claims 20, 21, 23-27, 32 and 39, the preamble "A", as opposed to "The" is queried.

In claim 20, 21, 23, 26, 32 and 39, there is no express antecedent basis for "copolymers" or "they".

In claim 20, it is not clear upon what total the recited amounts are based upon.

In claim 21, the awkward language "component natural polyamides" is confusing.

In claim 21, it is unclear if or how the narrower recitation "particularly preferably" limits the antecedently recited broader recitation.

In claim 21, "bone glues" is indefinite as to scope and meaning.

In claim 21, it is unclear as to whether or not the language "and degradation products thereof" limits all of the recited polyamide species.

In claim 23, the language "or unbranched non-aromatic aldehydes formaldehyde, acetaldehyde and glyoxal" is indefinite in that it is unclear as to whether all three aldehydes in combination are required.

In claim 27, "a disulfites of an alkali metal or aluminum, iron or ammonium" is confusing.

In claim 39, the language is confusing and furthermore it is not clear upon what total the recited amounts are based upon.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-21, 23-27, 32, 36 and 39 are rejected under 35 U.S.C. 102(c) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,681,856 (Chatterji et al).

Chatterji et al disclose a cement composition comprising a water soluble biodegradable cement dispersant comprising a polyamide graft copolymer containing at least one side chain formed from aldehydes and sulfur-containing acids or their salts. The reference provides various embodiments meeting the requirements of the present claims both in terms of the types of materials added and their contents. Given its chemical similarity to that presently claimed, it is reasonably believed that the polyamide graft copolymer of the reference would inherently meet all the properties governing that presently claimed. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ana L. Woodward/
Primary Examiner
Art Unit 1796